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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/056,106
Filing Date: January 25, 2002
Appellant(s): TSUDA ET AL.

Lisa L.B. Yociss
For Appellant

EXAMINER'S ANSWER

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This is in response to the appeal brief filed February 26, 2007 appealing from the Office action mailed September 26, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 13-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876). Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

In the current application, claims 13-18 recite method steps for executing a workflow. While the preamble recites computer terminals and a network, mere recitation in the preamble is not enough to tie one of the steps of the process to another statutory class. Thus, claims 13-18 fail the first prong of the new Federal Circuit decision since it is not tied to another statutory class and can be preformed without the use of a particular apparatus and it is respectfully submitted that claims 1-5 are directed to non-statutory subject matter.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 13-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876). Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

In the current application, claims 13-18 recite method steps for executing a workflow. While the preamble recites computer terminals and a network, mere recitation in the preamble is not enough to tie one of the steps of the process to another statutory class. Thus, claims 13-18 fail the first prong of the new Federal Circuit decision since it is not tied to another statutory

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class and can be preformed without the use of a particular apparatus and it is respectfully submitted that claims 1-5 are directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 7-10 and 12-15 are rejected under 35 U.S.C. 102(e) as being anticipated by DeFrancesco, Jr. et al. (U.S. Patent No. 6505176).

As per claim 7, DeFrancesco et al. teach:

A workflow server for managing a workflow connected to a plurality of computer terminals, comprising:

a workflow definition management subsystem for managing workflow definitions, said workflow definitions being designed to define a workflow that includes nodes that may be skipped and recovery nodes, the recovery nodes indicating points in the workflow where skipped nodes are executed (see column 4 lines 61-65, column 5 lines 18-32, column 7 lines 61-67, column 8 lines 1-8, column 9 lines 34-67, column 10 lines 1-67, and column 13 lines 38-50; where computer terminals design the workflow process. The workflow design can set steps to have specific tests run on each process step. The step can be designated as waived or skipped. A process that does not have a status of "complete" is re-performed until a time it is

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designated as complete. Where there is an exception step, both the skip and complete tests apply and at the failure of either test, a user is prompted to re-execute the failed processes. The exception step is again submitted to both skip and completion tests after re-processing.);

a process management subsystem for managing processes created by using said workflow definitions (see column 3 lines 21-67; where workflow definitions are created using process lists. The workflow system manages all process definitions created for use in the workflow system.);

a client request management subsystem for accepting a request from a person operating said computer terminal (see column 3 lines 21-67 and column 4 lines 61-65; where client requests are controlled by client workstations.); and

a user management subsystem for controlling assignment of a person based on stored information about said person (see column 3 lines 61-67, column 6 lines 8-24, and column 7 lines 29-38; where workflow steps are assigned to individuals and work groups. Work groups and the individuals in the workgroup are defined in the workflow definitions.).

As per claim 8, DeFrancesco et al. teach:

The workflow server of claim 7, wherein said process management subsystem automatically or manually ends an activity that is determined to be skipped, the activity serving as a transaction for each person forming said process, and then starts a next activity (see column 9 lines 34-67 and column 10 lines 1-67; where the test of completion can be performed on workflow steps. If a workflow transaction is complete, the next step in the workflow becomes active and available for performance.).

As per claim 9, DeFrancesco et al. teach:

The workflow server of claim 8, wherein said process management subsystem stores information about the skipped activity as a skip list and assigns the skipped activity to an appropriate person by referring to the skip list when proceeding to processing of said recovery node while performing activities in sequence (see column 9 lines 34-67 and column 10 lines 1-67; where the workflow queue serves as an activity list of processes that need to be completed. Skipped activities are stored in workflow definitions and processes to skip if predetermined conditions are met. Until steps are “noticeable” processes are repeated until the step is “noticeable”. A specific user or work group is assigned to complete the activity.).

As per claim 10, DeFrancesco et al. teach:

An information processing apparatus for defining a workflow to be executed by a plurality of computer terminals connected to a network, comprising:

a plurality of nodes corresponding to business processes assigned to persons in charge of execution of the workflow (see column 3 lines 61-67, column 6 lines 8-24, and column 7 lines 29-38; where workflow steps are assigned to individuals and work groups. Work groups and the individuals in the workgroup are defined in the workflow definitions.);

means for establishing a workflow using paths to connect the plurality of nodes (see column 4 lines 61-65, column 5 lines 18-32, column 7 lines 61-67, column 8 lines 1-8, column 9 lines 34-67, column 10 lines 1-67, and figure 4; where the workflow configurator tool is used to design the workflow. The workflow configurator allows for the creation of workflow steps using workflow rule elements and workflow tests. The workflow steps are the same as activities and nodes. The workflow tests designate re-execution points and can serve as a recovery node.);

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means for establishing at least one node among said plurality of nodes in the workflow that may be skipped during execution of the workflow (see column 9 lines 34-67 and column 10 lines 1-67; where the system allows a designer to implement tests for each workflow step. One of the tests is to determine whether a workflow step should be skipped.); and

means for establishing at least one recovery node in said flow to define points on the workflow where transactions that were part of the at least one skipped node are executed (see column 4 lines 61-65, column 5 lines 18-32, column 7 lines 61-67, column 8 lines 1-8, column 9 lines 34-67, column 10 lines 1-67, and figure 4; where the workflow configurator tool is used to design the workflow. The workflow configurator allows for the creation of workflow steps using workflow rule elements and workflow tests. The workflow steps are the same as activities and nodes. The workflow tests designate re-execution points and can serve as a recovery node. Further where there is an exception step, both the skip and complete tests apply and at the failure of either test, a user is prompted to re-execute the failed processes. The exception step is again submitted to both skip and completion tests after re-processing.).

As per claim 12, DeFrancesco et al. teach:

The information processing apparatus of claim 10, further comprising means for defining conditions for causing an automatic skip operation for said at least one skippable node established by said means for establishing said at least one skippable node (see column 9 lines 34-67 and column 10 lines 1-67; where a workflow step is skipped based on when predefined conditions are satisfied. A predefined condition is a property that a workflow designer can define, such as assigning the skip test to a workflow step.).

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As per claim 13, DeFrancesco et al. teach:

A method for defining a workflow executed at a plurality of computer terminals connected to a network, the method comprising the steps of:

Defining a workflow by defining nodes that serve as business processes that are assigned to persons in charge of execution of the workflow (see column 3 lines 61-67, column 6 lines 8-24, and column 7 lines 29-38; where workflow steps are assigned to individuals and work groups. Work groups and the individuals in the workgroup are defined in the workflow definitions.);

Designating at least one of said nodes as a node that may be skipped during the execution of the workflow (see column 9 lines 34-67 and column 10 lines 1-67; where the system allows a designer to implement tests for each workflow step. One of the tests is to determine whether a workflow step should be skipped.); and

Designating at least one recovery node that indicates a re-execution point in the workflow where the persons in charge of a previously skipped node re-execute the business processes (see column 4 lines 61-65, column 5 lines 18-32, column 7 lines 61-67, column 8 lines 1-8, column 9 lines 34-67, column 10 lines 1-67, and figure 4; where the workflow configurator tool is used to design the workflow. The workflow configurator allows for the creation of workflow steps using workflow rule elements and workflow tests. The workflow steps are the same as activities and nodes. Further where there is an exception step, both the skip and complete tests apply and at the failure of either test, a user is prompted to re-execute the failed processes. The workflow tests designate re-execution points and can serve as a recovery node.).

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As per claim 14, DeFrancesco et al. teach:

The method of claim 13, further comprising the steps of: forming a workflow using said established nodes and paths to determine a sequence of the business processes; and establishing said at least one recovery node at predetermined points on said workflow (see column 4 lines 61-65, column 5 lines 18-32, column 7 lines 61-67, column 8 lines 1-8, column 9 lines 34-67, column 10 lines 1-67, and figure 4; where the workflow configurator tool is used to design the workflow. The workflow configurator allows for the creation of workflow steps using workflow rule elements and workflow tests. The workflow steps are the same as activities and nodes. The workflow tests designate re-execution points and can serve as a recovery node.).

As per claim 15, DeFrancesco et al. teach:

The method of claim 13, further comprising the step of establishing conditions for skipping any of said established nodes determined to be skippable (see column 9 lines 34-67 and column 10 lines 1-67; where a workflow step is skipped based on when predefined conditions are satisfied. A predefined condition is a property that a workflow designer can define, such as assigning the skip test to a workflow step.).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 11, and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeFrancesco, Jr. et al. (U.S. Patent No. 6505176) in view of Gabbita et al. (U.S. Patent No. 6349238).

As per claim 1, DeFrancesco et al. teach:

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A workflow system, comprising:

design computer terminals for designing a workflow (see column 4 lines 61-65, column 5 lines 18-32, column 7 lines 61-67, and column 8 lines 1-8; where a network of computers is interacting with the workflow server. Process design is done using a workflow configuration tool.);

operation computer terminals for executing said workflow (see column 4 lines 61-65, column 5 lines 18-32, column 7 lines 61-67, and column 8 lines 1-8; where workflow users are prompted for functions and actions through the use of a network of computers.); and

a workflow server for managing said workflow connected to said design computer terminals and operation computer terminals via a network, wherein said design computer terminals design the workflow by defining in advance activities that may be skipped and re-execution points in said workflow where previously skipped activities are executed and wherein said workflow server performs skip processing and reassignment processing for said operation computer terminals based on said workflow designed by said design computer terminals (see column 4 lines 61-65, column 5 lines 18-32, column 7 lines 61-67, column 8 lines 1-8, column 9 lines 34-67, column 10 lines 1-67, and column 13 lines 38-50; where computer terminals design the workflow process. The workflow design can set steps to have specific tests run on each process step. The step can be designated as waived or skipped. A process that does not have a status of "complete" is re-performed until a time it is designated as complete. Where there is an exception step, both the skip and complete tests apply and at the failure of either test, a user is prompted to re-execute the failed processes. The exception step is again submitted to both skip and completion tests after re-processing.).

Though DeFrancesco et al. teach re-performing skipped activities, DeFrancesco fail to explicitly teach performing reassignment of the activities. Gabbita et al. teach reassignment of workflow processes (see column 3 lines 7-14 and column 29 lines 20-67; where workflow processes, such as service orders, can be reassigned using remote workstations). The advantages of reassigning workflow processes is that the workflow step can be performed by an available resource thereby removing the bottleneck of the workflow system and increasing efficiency. It would have been obvious, at the time of the invention, for one of ordinary skill in the art to combine the feature of reassigning workflow processes of the Gabbita et al. system to the DeFrancesco et al. system in order to remove bottlenecks from the system and increasing the efficiency of the system, which is a goal of Gabbita et al. (see column 1 lines 38-44).

As per claim 2, DeFrancesco et al. teach:

The workflow system of claim 1, wherein said design computer terminals design the workflow using a plurality of nodes serving as activities that perform transactions, at least one recovery node serving as said re-execution point, and paths connecting the nodes and recovery node (see column 4 lines 61-65, column 5 lines 18-32, column 7 lines 61-67, column 8 lines 1-8, column 9 lines 34-67, column 10 lines 1-67, column 13 lines 38-50, and figure 4; where the workflow configurator tool is used to design the workflow. The workflow configurator allows for the creation of workflow steps using workflow rule elements and workflow tests. The workflow steps are the same as activities and nodes. Where there is an exception step, both the skip and complete tests apply and at the failure of either test, a user is prompted to re-execute the failed processes. The exception step is again

submitted to both skip and completion tests after re-processing. The workflow tests designate re-execution points and can serve as a recovery node.).

As per claim 3, DeFrancesco et al. teach:

A workflow system, comprising:

computer terminals for executing a workflow (see column 4 lines 61-65; where a plurality of workstations are used for executing a workflow); and

a workflow server for managing said workflow connected to said computer terminals via a network (column 5 lines 18-32, column 7 lines 61-67, and column 8 lines 1-8; where a workflow server is connected to a plurality of workstations for executing the workflow), wherein said workflow server comprises:

means for defining a process flow by assigning transactions to predetermined operators, who operate said computer terminals, based on a workflow definition defining a process flow (see column 3 lines 61-67, column 6 lines 8-24, column 7 lines 29-38, column 7 lines 62-67, and column 8 lines 1-8; where workflow steps are assigned to individuals and work groups. The workflow is defined by a user in process steps.);

means for performing skip processing automatically or manually according to directions from said computer terminals for skipping part of the process flow by skipping one of said operators to whom the transaction is assigned (see column 9 lines 34-67 and column 10 lines 1-67; where the system allows a designer to implement tests for each workflow step. One of the tests is to determine whether a workflow step should be skipped.)

wherein the skipped transaction is executed (see column 13 lines 38-50; where there is an exception step, both the skip and complete tests apply and at the failure of either test, a user

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is prompted to re-execute the failed processes. The exception step is again submitted to both skip and completion tests after re-processing).

DeFrancesco et al. fails to teach reassigning activities or transactions. This limitation is addressed by the rejection of claim 1; therefore the same rejection applies here.

As per claim 4, DeFrancesco et al. teach:

The workflow system of claim 3, wherein said computer terminals send out completion of the transaction to the workflow server after performing the transaction assigned by said workflow server, wherein said transaction assigning means of the workflow server assigns a next transactor in response to the completion of said transaction from said computer terminals (see column 9 lines 34-67 and column 10 lines 1-67; where the test of completion can be performed on workflow steps. If a workflow transaction is complete, the next step in the workflow becomes active and available for performance.).

As per claim 5, DeFrancesco et al. teach:

A workflow server for managing a workflow connected to a plurality of computer terminals, comprising:

means for assigning to a predetermined person a transaction performed as a business process transaction (see column 3 lines 61-67, column 6 lines 8-24, and column 7 lines 29-38; where workflow steps are assigned to individuals and work groups. Work groups and the individuals in the workgroup are defined in the workflow definitions.);

means for performing skip processing to skip the transaction assigned to said person (see column 4 lines 61-65, column 5 lines 18-32, column 7 lines 61-67, column 8 lines 1-8, column 9 lines 34-67, and column 10 lines 1-67; where computer terminals design the

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workflow process. The workflow design can set steps to have specific tests run on each process step. The step can be designated as waived or skipped. A process that does not have a status of "complete" is re-performed until a time it is designated as complete.).

Though DeFrancesco et al. teach re-performing skipped activities, DeFrancesco fail to explicitly teach performing reassignment of the activities. This limitation is addressed by the rejection of claim 1; therefore the same rejection applies here.

As per claim 6, DeFrancesco et al. teach:

The workflow server of claim 5, wherein said skip processing is performed when a skip request is received from a predetermined computer terminal connected to a network or when predefined conditions are satisfied (see column 9 lines 34-67 and column 10 lines 1-67; where a workflow step is skipped based on when predefined conditions are satisfied. A predefined condition is a property that a workflow designer can define, such as assigning the skip test to a workflow step.).

As per claim 11, DeFrancesco et al. teach:

The information processing apparatus of claim 10, wherein said means for establishing a flow displays said plurality of nodes, while said means for establishing at least one recovery node displays said at least one recovery node with at least one predetermined recovery icon and connects said at least one recovery node with predetermined nodes using said paths (see column 4 lines 61-65, column 5 lines 18-32, column 7 lines 61-67, column 8 lines 1-8, column 9 lines 34-67, column 10 lines 1-67, and figure 4; where the workflow configurator tool is used to design the workflow. The workflow configurator allows for the creation of workflow steps using workflow rule elements and workflow tests. The workflow steps are

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the same as activities and nodes. The workflow tests designate re-execution points and can serve as a recovery node.).

DeFrancesco et al. fail to teach the use of icons and arrows to represent business processes. It is old and well-known in the art to use icons and arrows to designate workflow processes and steps in workflow systems. The advantage of using icons and arrows is that the use of graphical objects facilitates the designer's ability to create workflow definitions. It would have been obvious, at the time of the invention, for one of ordinary skill in the art to use icons and arrows in the DeFrancesco system in order to facilitate the designer's ability to create workflow definitions for the workflow processes, which is a goal of DeFrancesco (see column 3 lines 1-19).

As per claim 16, DeFrancesco et al. teach:

A method for executing a workflow executed at a plurality of computer terminals connected to a network, the method comprising the steps of:

assigning activities that are performed as transactions of business processes in the workflow to predetermined persons who operate the computer terminals (see column 3 lines 61-67, column 6 lines 8-24, and column 7 lines 29-38; where workflow steps are assigned to individuals and work groups. Work groups and the individuals in the workgroup are defined in the workflow definitions.);

performing skip processing to skip at least one activity assigned to said persons (see column 9 lines 34-67 and column 10 lines 1-67; where the system allows a designer to implement tests for each workflow step. One of the tests is to determine whether a workflow step should be skipped.); and

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DeFrancesco et al. fail to teach assigning re-execution of activities to persons. This limitation is addressed by the rejection of claim 1; therefore the same rejection applies here.

As per claim 17, DeFrancesco et al. teach:

The method of claim 16, wherein a list of said activities assigned to each person is stored as a wordlist, and wherein a transaction is performed by retrieving a transaction request from said work list (see figure 7; where activities are stored sequentially in a process list to be performed. A process list is the same as a worklist.).

As per claim 18, DeFrancesco et al. teach:

The method of claim 16, wherein information about any of said persons whose assigned activities have been skipped is stored as a skip list (see column 9 lines 34-67 and column 10 lines 1-67; where the workflow queue serves as an activity list of processes that need to be completed. Skipped activities are stored in workflow definitions and processes to skip if predetermined conditions are met. Until steps are “noticeable” processes are repeated until the step is “noticeable”. A specific user or work group is assigned to complete the activity.)

DeFrancesco et al. fail to teach assigning re-execution of activities to persons. This limitation is addressed by the rejection of claim 1; therefore the same rejection applies here.

As per claim 19, DeFrancesco et al. teach:

A computer-readable storage medium for storing a program code executable by a computer, the program code comprising the steps of:

establishing nodes serving as business processes that are assigned to persons in charge of execution of a workflow, the nodes being included in the workflow (see column 3 lines 61-67, column 6 lines 8-24, and column 7 lines 29-38; where workflow steps are assigned to

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individuals and work groups. Work groups and the individuals in the workgroup are defined in the workflow definitions.);

indicating that at least one of the nodes of the workflow may be skipped if the business processes of the at least one node cannot be completed when the workflow defines that the at least one node is to be executed (see column 9 lines 34-67 and column 10 lines 1-67; where the system allows a designer to implement tests for each workflow step. One of the tests is to determine whether a workflow step should be skipped.); and

establishing at least one recovery node where the persons in charge of skipped nodes re-execute the business processes (see column 4 lines 61-65, column 5 lines 18-32, column 7 lines 61-67, column 8 lines 1-8, column 9 lines 34-67, column 10 lines 1-67, column 13 lines 38-50 and figure 4; where the workflow configurator tool is used to design the workflow. The workflow configurator allows for the creation of workflow steps using workflow rule elements and workflow tests. The workflow steps are the same as activities and nodes. The workflow tests designate re-execution points and can serve as a recovery node. Where there is an exception step, both the skip and complete tests apply and at the failure of either test, a user is prompted to re-execute the failed processes. The exception step is again submitted to both skip and completion tests after re-processing).

DeFrancesco et al. fail to teach assigning re-execution of activities to persons. This limitation is addressed by the rejection of claim 1; therefore the same rejection applies here.

As per claim 20, DeFrancesco et al. teach:

A computer-readable storage medium for storing a program code executable by a computer, the program code comprising the steps of:

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assigning activities that are performed as a transaction of business processes in a workflow to predetermined persons in charge (see column 3 lines 61-67, column 6 lines 8-24, and column 7 lines 29-38; where workflow steps are assigned to individuals and work groups. Work groups and the individuals in the workgroup are defined in the workflow definitions.);

performing skip processing to skip one or more activities assigned to said persons (see column 9 lines 34-67 and column 10 lines 1-67; where the system allows a designer to implement tests for each workflow step. One of the tests is to determine whether a workflow step should be skipped.).

DeFrancesco et al. fail to teach assigning re-execution of activities to persons. This limitation is addressed by the rejection of claim 1; therefore the same rejection applies here.

(10) Response to Argument

In the Appeal Brief, Appellant argues:

DeFrancesco fails to teach “executing skipped steps” as per claims 1-20. Examiner respectfully disagrees with this argument for the following reasons: 1) the recited claim language does not require DeFrancesco to teach “executing skipped steps” and 2) DeFrancesco does teach “executing skipped steps”.

1) The recited claim language fails to require a teaching of “executing skipped steps”.

Claim 7 recites “...workflow definitions being designed to define a workflow that includes nodes that *may* be skipped and recovery nodes, the recover nodes indicating points in the workflow where skipped nodes are executed” (emphasis added). The explicitly language of this claim dictates that the workflow may or may not have skipped nodes, thus a workflow in the

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present invention may not have any skipped nodes. Since a workflow can be created without any skipped nodes, a specific teaching of a workflow with skipped nodes is not necessary.

Independent claims 1, 10, 13, and 19 explicitly recite that the skip step *may* occur. Independent claims 3, 5, 16, and 20 are construed in the same manner as dictated by the skip processing functionality described in pages 18 and 19 of the Specification.

2) DeFrancesco does teach “executing skipped steps”.

DeFrancesco explicitly teaches “executing skipped steps”. DeFrancesco teaches that in steps, each step is evaluated against tests that determine whether the step is complete or skipped (see column 9 lines 33-45). However, for exception steps, skip tests and completion tests are the same (see column 13 lines 38-50). If either test fails for an exception step, the step receives a status of incomplete (column 13 lines 42-44). This status will prompt attention from a user to perform some required action (see column 13 lines 44-45). Once the user action is performed, the steps are then re-executed (see column 13 lines 45-46). From these teachings, it is clear that a workflow step will be re-executed if it fails either a completion test or a skip test. Examiner notes that if the step fails the completion test, it is still being re-executed. Appellants in their arguments are improperly interchanging the terms “test” and “step”. The cited portion of DeFrancesco clearly states that the status of a skipped exception *rule* is non-applicable (see column 13 lines 49-50).

Examiner cited this portion of DeFrancesco as it clearly illustrates this feature.

DeFrancesco further discusses “executing skipped steps” in its discussion of executing parent and child steps (see column 15 lines 20-29). DeFrancesco teaches that if a parent step is found to have a child step, the parent step is skipped until all of the child steps have been executed (see

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column 15 lines 20-29). Upon completion of the dependent child steps, the skipped parent step is then executed (see column 15 lines 20-29). Furthermore, DeFrancesco contemplates the performance of steps not necessarily in any order (see column 8 lines 48-50).

Appellants additionally argue that i) it does not make sense that a completion test be performed on an already skipped test and ii) DeFrancesco fails to teach skippable step. First, it does make sense that a completion test be performed on an already skipped step. DeFrancesco teaches that steps and rules are continuously being re-evaluated based on updated information so that proper workflow functionality is performed (see column 7 lines 47-54). Thus, previously skipped steps may need to be performed based on updated data. Second, Appellants' argument that DeFrancesco fails to teach "skippable" steps. This argument is completely without merit. Not only is the feature of "skippable" steps not recited in the claims, Appellants have failed to provide any evidence that distinguishes functional differences between these two terms. Furthermore, Appellants admit that DeFrancesco teaches "skipped step" as recited in the claims (see Appeal Brief page 14).

Appellants further argue that the cited references, DeFrancesco and Gabbita, fail to teach other independent and dependent claims for the same reasons as the arguments addressed above. These arguments are not persuasive for the same reasons as discussed above.

In conclusion, Appellant's arguments have been fully considered, but are found unpersuasive.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

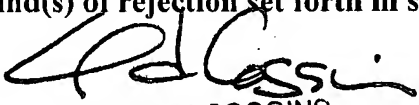
(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

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Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:


WYNN W. COGGINS
TECHNOLOGY CENTER DIRECTOR

Respectfully submitted,

Kalyan Deshpande
Patent Examiner
Art Unit 3623

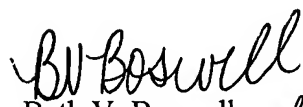


Conferees:

Art Unit: 3623

Vincent Millin
Appeal Conference Specialist

A handwritten signature in black ink, appearing to read "Vincent Millin".


Beth V. Boswell *evb*
Supervisory Patent Examiner
Art Unit 3623